

REMARKS/ARGUMENTS

Reconsideration and withdrawal of the rejections set forth in the Final Office Action dated November 25, 2009 are respectfully requested in view of the arguments and amendments presented herein.

Status of the Claims

Claims 49-51, 53-56 and 58-70 are currently pending. No amendments or new claims have been submitted in the instant response.

Interview Summary

A telephonic interview was held on April 16, 2010 between Examiner Siefke and Applicants' representative, David Weber. The undersigned wishes to thank the Examiner for his time to discuss the merits of the present case. During the interview independent claims 49 and 61 were discussed relative to the art of record. No agreement was reached.

Disclosure Statement

In response to Applicants' request that the Examiner send Applicants an initialed copy of the Form PTO 1449, the current Office Action states, "The two Japanese documents are not considered in the IDS as the Office does not consider an interpretation of a reference from a foreign office. The Applicant must submit a translated English abstract for the two documents to be considered."

In response, Applicants submit herewith an abstract of Japanese Laid-open Publication Number 2001-194372. Applicants also submit herewith a copy of WO95/11294, which the Japanese Patent Office indicates as the counterpart to Japanese National Phase PCT Laid-Open Publication No. 9-510863.

In view of these attachments, Applicants request that the Examiner send Applicants an initialed copy of the Form PTO 1449 submitted on September 27, 2004 (i.e., in which the documents are not crossed-through) in the next communication from the U.S. Patent and Trademark Office, so that the Examiner's consideration of the disclosure statement is clearly reflected in the record.

Response to § 102 Rejection

Claims 49-51, 53-56 and 58-70 stand rejected under 35 U.S.C. 1 02(b) as being anticipated by USPN 4,981,801 ("Suzuki"). Applicants traverse the rejection for the following reasons.

Claim 49 is directed to a system for manipulating and thermal cycling a sample well tray comprising, in pertinent part, a sample well tray handling apparatus and only one sample block, the only one sample block comprising a plurality of openings for receiving sample wells of the sample well tray and the handling apparatus configured to remove the sample well tray from a location proximal the sampling block to a location distal to the sample block. Suzuki does not disclose all the limitations of claim 49.

For example, Suzuki does not disclose a system having only one sample block. Instead, Suzuki discloses a reaction unit (system) that possesses a plurality of thermostats 71-75 and a stage 76, all disposed at various locations on the reaction unit. The stage 76 of the reaction unit is kept at room temperature, while thermostats 71-75 of the reaction unit are maintained at specified temperatures. During operation, a rack 88 holding a plurality of reaction vessels 87 is successively transported between the various locations on the reaction unit to effect a desired reaction. Suzuki, column 11, lines 18-40 and 49-53. Thus, Suzuki does not disclose a system having only one sample block, as required by claim 49, but rather discloses a plurality of stations at different temperatures that are all on a common reaction unit and together effect a desired reaction.

The current Office Action asserts, on page 3 thereof, that "comprises" language is open ended claim language which allows for more than one sample block to exist in the prior art. In response, Applicants respectfully submit that the mere fact that a claim includes the transition "comprising" does not allow the Office to ignore the clear meaning of the language of the claim. Applicants respectfully submit that the present case is analogous to *In re Skvorecz*, 580 F.3d 1262 (Fed. Cir. 2009) (copy submitted herewith). In that case the Federal Circuit found that even though the claims at issue used "comprising," the Office was not allowed to interpret the claims so broadly as to be inconsistent with the plain language of the claims. The *Skvorecz* case involved claims reciting that each wire leg had an offset. The cited prior art disclosed a device having some legs with offsets and others without offsets. The Federal Circuit found that the Office incorrectly applied the "broadest reasonable interpretation" to interpret "comprising" to mean that not all the claimed legs needed to have offsets, considering that the claims recited that

"each wire leg" had an offset. *Skvorecz*, 580 F.3d 1268. As a result, Applicants respectfully submit that it is improper in the present case for the Office to ignore "only one" just because the claims use "comprising."

In addition, Suzuki also does not disclose a sample block in combination with a sample well tray handling apparatus that is configured to move a sample well tray from a first location distal to the sample block. Instead, as discussed above, Suzuki discloses a reaction unit in combination with an apparatus configured to transport a plurality of reaction vessels between different locations on the same reaction unit. Thus, rather than a sample block in combination with a sample well tray handling apparatus configured to move a sample well tray from a distal location to the sample block, Suzuki discloses moving a plurality of reaction vessels to different locations on a common reaction unit.

Furthermore, Suzuki does not disclose any sample block comprising a plurality of openings for receiving sample wells of a sample well tray, as required by claim 49. Instead, Suzuki discloses a plurality of reaction vessels (sample wells) 87 held in a rack 88, wherein the sample wells are immersed into various thermostat liquids maintained at different temperatures. Suzuki, column 11, lines 49-53 and column 12, lines 4-26. Thus, rather than disclosing a plurality of openings for receiving sample wells, as required by claim 49, Suzuki discloses a plurality of reaction vessels that are immersed into various liquids.

Before discussing at least some of the limitations of independent **claim 61** that distinguish over Suzuki, Applicants first wish to point out that **the current Office Action fails to provide any reasons or evidence supporting the assertion that claim 61 is anticipated by Suzuki**. Therefore, Applicants respectfully assert that claims 61-70 are allowable in their present condition. However, in an effort to be more fully responsive to the current Office Action, Applicants offer the following remarks.

Claim 61 is directed to a system for manipulating and thermal cycling a sample well tray comprising, in pertinent part, a sample well tray handling apparatus and a thermal cycling device consisting of only one sample block, the sample well tray handling apparatus configured to remove the sample well tray from a location proximal the sampling block to a location distal to the sample block. Suzuki does not disclose all the limitations of claim 61.

For example, Suzuki does not disclose a thermal cycling device consisting of only one sample block. Instead, Suzuki discloses a reaction unit having a plurality of thermostat liquids.

Suzuki, column 12, lines 4-26. Thus, Suzuki does not disclose a thermal cycling device consisting of only one sample block, as required by claim 61, but rather discloses a plurality of stations at different temperatures that are all on a common reaction unit and together effect a desired reaction

On page 3 of the previous Office Action mailed on June 8, 2009, the Office Action states that:

“‘comprises’ language is open ended claim language which allows for more than one sample block to exist in the prior art.... If Applicant requires ‘only one’ sample block then the claim language needs to include ‘consisting’ instead of ‘comprising’.”

Thus, even if “comprises” may be interpreted as asserted above by the current Office Action, the Office appears to at least admit that using “consisting” instead of “comprising” does not allow for more than one sample block to exist in the prior art. Independent claim 61 includes the limitation of a thermal cycling device consisting of only one sample block. Accordingly, Applicants respectfully assert that claim 61 is patentable over Suzuki at least because the limitation “a thermal cycling device consisting of only one sample block” does not allow for more than one sample block to exist in the prior art (e.g., Suzuki).

Even assuming *arguendo* that claim 61 does allow for more than one sample block, claim 61 still contains other limitations that distinguish over Suzuki. For example, Suzuki does not disclose a sample block in combination with a sample well tray handling apparatus that is configured to move a sample well tray from a first location distal to the sample block. Instead, Suzuki discloses a reaction unit in combination with an apparatus configured to transport a plurality of reaction vessels between various locations of the reaction unit. Thus, rather than a sample block in combination with a sample well tray handling apparatus configured to move a sample well tray from a distal location to the sample block, Suzuki discloses moving a plurality of reaction vessels to different locations on a common reaction unit.

In addition, Suzuki does not disclose any sample block comprising a plurality of openings for receiving sample wells of a sample well tray, as required by claim 61. Instead, Suzuki discloses a plurality of reaction vessels (sample wells) 87 held in a rack 88, wherein the sample wells are immersed into various thermostat liquids maintained at different temperatures. Suzuki, column 11, lines 49-53 and column 12, lines 4-26. Thus, rather than disclosing a plurality of

openings for receiving sample wells, as required by claim 61, Suzuki disclose a plurality of reaction vessels immersed into various liquids.

As shown above in greater detail, the relied on disclosure of Suzuki fails to disclose a system for manipulating and thermal cycling a sample well tray, comprising only one sample block for receiving the sample well tray. Suzuki states, "In the reaction unit, five thermostats 71 to 75 and one stage 76 are arranged." Suzuki at col. 11, lines 22-23. Suzuki further states, "In this embodiment, as shown in FIGS. 8 to 10 in detail, a rack 88 for holding one hundred reaction vessels 87 in a matrix is successively transported between the thermostats 71 to 75 so as to effect the desired reaction." Id. at col. 11, lines 49-53. The relied on embodiment of Suzuki therefore involves five sample blocks 71 to 75. Thus, the relied on disclosure of Suzuki fails to disclose a system for manipulating and thermal cycling a sample well tray, comprising only one sample block for receiving the sample well tray.

In view of the above, Applicants respectfully request withdrawal of the rejection claims 49-51, 53-56 and 58-70 over Suzuki.

CONCLUSION

For the foregoing reasons, Applicants respectfully assert that the claims now pending are allowable over the prior art of record. Therefore, Applicants earnestly seek a notice of allowance and prompt issuance of this application.

The Commissioner is hereby authorized to charge payment of any fees associated with this communication to Deposit Account No. 503994.

Respectfully submitted,
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Dated: April 26, 2010

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